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ZILKA-KOTAB, PC

NO. 3726 P. 22



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,788	09/11/2003	Kevin J. Zilka	SVIPGP002D	8357
28875	7590	07/10/2006	EXAMINER	
Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			SPOONER, LAMONT M	
			ART UNIT	PAPER NUMBER
			2626	

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/661,788	ZILKA ET AL	
	Examiner	Art Unit	
	Lamont M. Spooner	2626	

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 11 September 2003.

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-19 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-19 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on 11 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)

Paper No(s)/Mail Date _____

4) ☐ Interview Summary (PTO-413)

Paper No(s)/Mail Date _____

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____

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DETAILED ACTION***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Rivette (US 6,014,663).

As per claim 1, Rivette teaches a method for conducting a search based on a patent claim utilizing a computer- implemented system, comprising:

Identifying at least one claim associated with a patent (Fig. 4 item 406); extracting a plurality of terms from the claim (fig. 5 item 501); and conducting a search utilizing the terms (C.9.lines 36-41).

As per claim 2, Rivette further teaches the method of claim 1, wherein the method is carried out utilizing computer code (C.3.lines 33-49).

As per claims 3, and 4, Rivette further teaches the method of claim 1, wherein the terms of the claim are manually entered into a

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predetermined field (C.7.lines 1-16, claim 3), and wherein the terms of the claim are automatically retrieved from a database (ibid, claim 4).

As per claim 13, Rivette further teaches wherein the search is conducted manually upon receiving a user request (C.10.lines 17-21).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5-12, 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. (Rivette, US 6,014,663) in view of Kupiec (US 5,696,962).

As per claims 5 and 6, Rivette teaches the method of claim 1, but lacks explicitly wherein noun terms of the claim are identified, and wherein verb terms of the claim are identified. However, Kupiec teaches noun and verb term identification (Fig. 3). Therefore, at the time of the invention, it would have been obvious to modify Rivette's search strategy with noun and verb identification. The motivation for

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doing so would have been to analyze, for broadening or narrowing a search (abstract).

As per claims 7-12, and 15-19, Rivette teaches claim terms (see claim 1, his claim terms as intellectual property asset associated with a patent), Kupiec further teaches Boolean searching based on terms, wherein AND operators are incorporated with the terms, a plurality of synonyms are identified based on the terms, utilizing a synonym database, incorporated with the terms to increase the breadth of the search, wherein the synonyms are incorporated with the terms utilizing an or operator, wherein a word is removed from the search terms, the terms are modified based on the results of the search, the search and user input, the terms are modified based on the results of the search automatically, conducting a patent search in a database of patents (C.10.line 30-C.11.line 13-boolean discussion, C.22.line 64-C.23.line 35-synonym discussion, word removal, terms modified by results low retrieval, and user directed modification by pre-specified user minima hit, as automatic modification, C.6.lines 19-37-current file directory as patent database). Therefore, at the time of the invention, it would have been obvious to modify Rivette's search strategy of claim terms of a patent with Boolean and synonym

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enhancement. The motivation for doing so would have been to broaden or narrow a search (abstract).

5. Claims 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. (Rivette, US 6,014,663) in view of Sanu et al. (Sanu, US 5,974,409).

As per claim 14, Rivette teaches claim 1, but lacks wherein the search is conducted automatically at predetermined intervals. However, Sanu teaches the lacking element (C.4.lines 31-37). Therefore, at the time of the invention, it would have been obvious to modify Rivette's search with an automatic search at predetermined intervals. The motivation for doing so would have been to accommodate constantly changing information for searches (ibid).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Nosohara (US 6,571,241) teaches multilingual patent information search system.
- Adler (US 2003/0033295) teaches claim identification and conducting searches based on claim terms.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lamont M. Spooner whose telephone number is 571/272-7613. The examiner can normally be reached on 8:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil can be reached on 571/272-7602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

lms
6/28/06



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SUPERVISORY PATENT EXAMINER